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November 22, 2004

To: Assistant Commissioner for Patents
Washington, D.C. 20231

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Attention: Examiner STEPHEN CHOI
Group Art Unit 3724
Phone Number: (703) 306-4523

Re: OFFICIAL RESPONSE UNDER 37 CFR §1.111

The following is an OFFICIAL RESPONSE to an Office Action filed October 20, 2004, in the below-identified U.S. Patent Application.

Application No. : 10/707,526
Applicant : Patrick C. Urschel et al.
Filed: : December 19, 2003
TC/Art Unit: : 3724
Examiner : Stephen Choi

Confirmation No. 1525

Docket No. : A3-1700

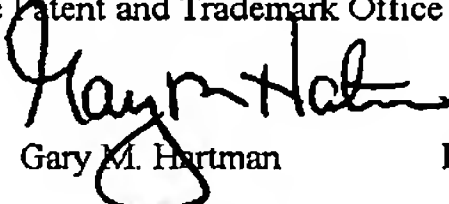
Submitted by:
Gary M. Hartman
Reg. No. 33,898

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Gary M. Hartman	Date: November 22, 2004

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant :	Patrick C. Urschel et al.	
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Customer No. :	27127	

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

RESPONSE TO RESTRICTION-ELECTION REQUIREMENT

In the Office Action of October 20, 2004 (Paper No. 10192004), the Examiner required that Applicants make an election under 35 USC §121 between claims 1-13 (Group I) drawn to a cutting apparatus, and claims 14-20 (Group II) drawn to a cutting method. The Examiner also cited the application as containing claims directed to patentably distinct species of the claimed invention, and required that Applicants elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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Docket No. A3-1700
Amendment dated November 22, 2004
Reply to Office Action of October 20, 2004

Restriction Requirement

Applicants elect to prosecute Group II, method claims 14-20, on the merits.

In doing so, Applicants respectfully traverse the restriction requirement and request reconsideration in view of the following comments.

The Examiner stated that the basis for restriction between the apparatus claims of Group I and the method claims of Group II was distinctiveness under MPEP 806.05(e), as process and apparatus for its practice. Restriction was said to be proper because

the process as claimed can be practiced by another materially different apparatus such as a cutting apparatus not requiring the specific means for individually delivering food products to the cutting means and the specific means for contacting the food products and positioning the food products set forth in group I.

Paragraph 2 of the Office Action.

However, this basis for restriction erroneously interprets Applicants' independent apparatus claim 1 as requiring "specific means for individually delivering food products to the cutting means" and "specific means for contacting the food products and positioning the food products," when in fact no such limitations exist in claim 1.

The Restriction Requirement as stated restricts independent apparatus and process claims 1 and 14 from each other, and not merely their dependent claims. Only dependent apparatus claims recite the "specific means for individually delivering food

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products to the cutting means” and the “specific means for contacting the food products and positioning the food products” cited as the basis for restriction. The mere fact that one or more dependent apparatus claims recite additional limitations to the apparatus *as claimed* in their parent apparatus claim 1 does *not* establish that the process *as claimed* in independent process claim 14 can be practiced by another and material different apparatus than the apparatus *as claimed* in claim 1. Accordingly, at the very least it is improper to impose a restriction between Group I apparatus claim 1 and Group II process claim 14, because the invention *as claimed* by independent process claim 14 has not been shown as being capable of being practiced by another and material different apparatus than the apparatus *as claimed* in independent apparatus claim 1.

In view of the above, Applicants respectfully request reconsideration of the restriction requirement between apparatus claims 1-13 (Group I) and process claims 14-20 (Group II).

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Election of Species

The Examiner stated that the application contains claims directed to the following patentably distinct species of the claimed invention:

Species A (Paragraph [0017]);
Species B (Paragraph [0018], lines 1-5);
Species C (Paragraph [0018], lines 5-16);
Species D (Figure 2);
Species E (Figure 3);
Species F (Figure 6);
Species G (Figure 7); and
Species H (Figure 8).

The Examiner required that Applicants elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Finally, the Examiner noted that "some claims may be generic."

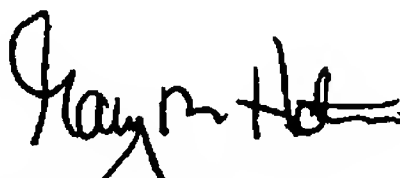
In response, Applicants hereby elect Species D (Figure 2) for prosecution on the merits if no generic claim is held to be allowable. Applicants believe that, of elected Group II claims 14-20, claims 14, 18, and 19 read on Species D (Applicants believe that these same claims also read on Species E). Finally, Applicants believe that, of elected Group II claims 14-20, independent claim 14 is generic.

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Closing

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

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